

### REMARKS

Applicant acknowledges receipt of an Office Action dated October 31, 2007. In this response, Applicant has amended claim 1 to incorporate the subject matter of claims 4 and 5 and add an additional element. As such, Applicant has cancelled claims 4-5. Support for this amendment may be found in the specification as originally filed, *inter alia*, on page 7, lines 1-4. Additionally, Applicant has amended claims 2-3 and 6-11 to conform the claims with U.S. practice and fix minor informalities. New claim 12 is added. Support for new claim 12 may be found in the specification as originally filed, *inter alia*, on page 5, lines 11-13 and page 8, lines 13-16. Following entry of this amendment, claims 1-3 and 6-12 are pending in the application.

Applicant respectfully requests reconsideration of the present application in view of the foregoing amendments and in view of the reasons that follow.

#### **Rejection Under 35 U.S.C. § 112, 2<sup>nd</sup> Paragraph**

On page 2 of the Office Action, the PTO has rejected claims 2-3, 5 and 7-11 under 35 U.S.C. § 112, 2<sup>nd</sup> paragraph, as allegedly being indefinite. Applicant has amended claims 2, 7-8, and 10-11 to correct the minor informalities cited by the PTO.

In view of the foregoing, Applicant respectfully requests reconsideration and withdrawal of the outstanding rejection under § 112.

#### **Rejection Under 35 U.S.C. § 102**

On page 3 of the Office Action, the PTO has rejected claims 1-4 and 7-10 under 35 U.S.C. § 102(b) as allegedly being anticipated by U.S. Patent 5,407,161 to Mulkeran (hereafter "Mulkeran"). Applicant respectfully traverses this rejection for at least the reason set forth below.

A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference. *Verdegaal Bros. v. Union Oil Co. of California*, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987). See generally MPEP § 2131.

Here, Mulkeran fails to disclose a fixing element wherein "the latching connection centers and fixes the oil cooler in the oil cooler receiving element, and the latching

connection is kept pretensioned in a desired position by an energy store, wherein the energy store is a spring store formed from a material tongue which is formed on the latching receiving element” as recited in independent claim 1.

In view of the foregoing, Applicant respectfully requests reconsideration and withdrawal of the outstanding rejection under § 102.

### **Rejection Under 35 U.S.C. § 103**

On page 4 of the Office Action, the PTO has rejected claims 5-6 and 11 under 35 U.S.C. § 103(a) as allegedly being unpatentable over Mulkeran in view of U.S. Patent 5,632,332 to Hanafusa (hereafter “Hanafusa”). Applicant respectfully traverses this rejection for at least the reasons set forth below.

In order to establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, prior art references must teach or suggest all the claim limitations. The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art, not in Applicant’s disclosure. *In re Vaeck*, 947 F.2d 488, 20 U.S.P.Q.2d 1438 (Fed. Cir. 1991).

Here, Mulkeran and Hanafusa, whether taken individually or in combination, fail to teach or suggest a fixing element wherein “the latching connection centers and fixes the oil cooler in the oil cooler receiving element, and the latching connection is kept pretensioned in a desired position by an energy store, wherein the energy store is a spring store formed from a material tongue which is formed on the latching receiving element” as recited in independent claim 1.

On page 4 of the Office Action, the PTO admits that Mulkeran fails to teach a spring. The PTO further states that “Hanafusa teaches the device is made of plastic (column 7, lines 13-17), since plastic is elastic which is considered as spring.” Applicant respectfully disagrees with the assertion that plastic inherently is a spring. Hanafusa provides “that their clamp fingers are capable of being plastically deformed.” Hanafusa, Col. 7, lns. 16-17.

Plastic deformation is not reversible while a spring undergoes elastic deformation and returns to its original length when tension is removed. Consequently, the clamp fingers that “are capable of being plastically deformed” as recited in Hanafusa are not the same as “a spring store formed from a material tongue which is formed on the latching receiving element” as required by independent claim 1.

Additionally, neither Mulkeran nor Hanafusa, either alone or in combination, disclose that the latching connection “centers and fixes the oil cooler in the oil cooler receiving element” as required by claim 1.

For at least these reasons, Applicant submits that the outstanding rejection based upon the combination of Mulkeran and Hanafusa has been overcome and ought to be withdrawn.

If an independent claim is nonobvious under § 103, then any claim depending therefrom is nonobvious. *In re Fine*, 5 USPQ2d 1596 (Fed. Cir. 1988). See MPEP 2143.03. Thus, Applicant submits that claims 2-3 and 6-11, each of which ultimately depends from independent claim 1, are also non-obvious at least by virtue of their dependency from claim 1.

In view of the foregoing, Applicant respectfully requests reconsideration and withdrawal of the outstanding rejection under § 103.

#### **Newly Added Claim**

In this response, Applicant has added claim 12 which ultimately depends from independent claim 1. Applicant believes that claim 12 is allowable by virtue of its dependency on independent claim 1, and also because of the additional features recited in claim 12.

#### **CONCLUSION**

Applicant believes that the present application is now in condition for allowance. Favorable reconsideration of the application as amended is respectfully requested.


The Examiner is invited to contact the undersigned by telephone if it is felt that a telephone interview would advance the prosecution of the present application.

The Commissioner is hereby authorized to charge any additional fees which may be required regarding this application under 37 C.F.R. §§ 1.16-1.17, or credit any overpayment,

to Deposit Account No. 19-0741. Should no proper payment be enclosed herewith, as by a check or credit card payment form being in the wrong amount, unsigned, post-dated, otherwise improper or informal or even entirely missing, the Commissioner is authorized to charge the unpaid amount to Deposit Account No. 19-0741. If any extensions of time are needed for timely acceptance of papers submitted herewith, Applicant hereby petitions for such extension under 37 C.F.R. § 1.136 and authorizes payment of any such extensions fees to Deposit Account No. 19-0741.

Respectfully submitted,

Date 2/29/08  
FOLEY & LARDNER LLP  
Customer Number: 22428  
Telephone: (202) 672-5540  
Facsimile: (202) 672-5399

By   
Paul D. Strain  
Registration No. 47,369  
Attorney for Applicant